

III. REMARKS

1. Claims 1-26 remain in the application. Claims 27-32 have been cancelled without prejudice.

2. Applicants respectfully submit that claims 1-3, 5-7, 9-12, 14-21, 23, 25 and 26 are patentable over the combination of Filler et al. (WO 00/11827, "Filler") in view of Yu et al. (US 6,684,087, "Yu").

The combination of Filler and Yu fails to disclose or suggest the following features of claim 1:

identifying a user of a cellular mobile phone in the communication network from subscriber identity information of the user in the cellular mobile communication network;
and

associating a digital collectible trading card with the user based on the subscriber identity information of the user in the cellular mobile communication network received from the cellular mobile phone.

The combination of Filler and Yu also fails to disclose or suggest the following features of claim 21:

a server communicating with a cellular mobile phone via the cellular mobile communication network for storing the digital collectible trading card and for associating the user with the digital collectible trading card, wherein the associating is based on subscriber identity information of the user in the cellular mobile communication network received from the cellular mobile phone.

Applicants find no disclosure in the combination of Filler and Yu related to identifying a user of a cellular mobile phone from subscriber identity information as recited in claim 1. Filler has no disclosure related to cellular mobile phones and requires a user name and password each time a user attempts to connect to the system. Yu has no disclosure related to identifying a user of a cellular mobile phone from subscriber identity information.

Applicants further submit that there is no disclosure in the cited references related to associating a digital collectible trading card with the user based on the subscriber identity information of the user received from the cellular mobile phone, as recited in claims 1 and 21. Yu has no disclosure related to this feature. Filler states in the Abstract that "the digital trading cards (30) are uniquely associated with a user that has purchased (20) and downloaded the cards," but has no disclosure related to associating a digital collectible trading card with the user based on the user's subscriber identity information received from the cellular mobile phone.

Applicants submit that the process of associating in Filler is remarkably different from the present invention. Applicants respectfully disagree with the Examiner's statement that because Filler's Abstract discloses that the digital trading cards are uniquely associated with a user, that Applicants arguments are moot.

"The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure" (37 CFR 1.72(b)). Filler's specification however, doesn't elaborate any further on the disclosure of the abstract but simply reiterates that the

trading cards are uniquely associated with a user. Filler fails to disclose any other kind of identification except 1) the general principle that the card is associated with the user and 2) in particular that the identification is only based on a user ID and a corresponding password.

Filler requires the user to enter a user ID and a password every time the user wants to use his fixed computer workstation to connect to the system. This is understandable because fixed computer workstations are very seldom personal enough to the extent that any centralized system could rely on the identification of a terminal device as something that would unambiguously also identify a certain user. Quite to the contrary, cellular mobile phones are strictly personal devices, with the subscription associated with a certain phone + SIM combination being very unambiguously related to the corresponding subscriber.

In contrast with Filler, the present invention, as set forth for example in claim 1, utilizes this unique feature of cellular mobile phone networks so that the identification of the user is made in the cellular mobile communication network based on subscriber identification information received from the cellular mobile phone. The present invention also utilizes the subscriber identity information of the user to associate the digital trading card with the user.

The independent claims have features that distinguish over the cited art. Applicants respectfully disagree that the use of mobile phones versus fixed computers is not a patentable step in performing the method. As stated in MPEP section 2143.03:

All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Applicants submit that: identifying a user of a cellular mobile phone in the communication network from subscriber identity information; and that, associating a digital collectible trading card with the user based on the subscriber identity information received from the cellular mobile phone; are clearly set out in the body of the claims, are patentable steps, and must be considered when determining the patentability of the claims.

Applicants further submit that both the identification and associating methods of the combination of Filler and Yu, if present at all, are completely different from those of the present invention.

The Examiner has correctly pointed out that Filler does not disclose mobility and Applicants appreciate that agreement has been reached on this point. However, in using Yu to provide the features of the present invention missing from Filler, it appears that the technical problem and other teachings discussed in Yu may have been misinterpreted.

First, Applicants note that Yu never even approaches the subject of handling digital collectible trading cards: the subject of Yu is simply handling some general form of digitally represented images. Applicant respectfully disagrees that the data of Yu is synonymous to the collectible digital trading card of the present invention. Yu teaches too general concept, thereby the

motivation and instructions for skilled person to make the combination is lacking.

Second, according to Yu a user identifier is only used for finding a certain user account and for generating certain instructions, according to which an image will be pre-processed in a proxy server. Associating an image with a user, which is the closest Yu ever gets to the present applicant's concept of associating a digital collectible trading card with the user, only takes place in Yu as a result of a very detailed and definite request explicitly made by the user. Thus, there is no associating a digital information of the user based on the subscriber identity of the user in the cellular mobile communication network received from the cellular mobile phone. Although Yu may include the words "subscriber ID," the subscriber ID of Yu is created and administered by a carrier administering link server 300 as part of the procedure for activating the account. The advantageous way of utilizing the subscriber identity of the user in the cellular mobile communication network for associating the card is missing. Thus, the features of the present invention are still missing from Yu and Filler.

At least for these reasons, Applicants respectfully submit that the combination Filler and Yu fails to disclose or suggest all the features of claims 1 and 21, and therefore claims 1 and 21 are patentable over the combination of Filler and Yu.

Claims 2, 3, 5-7, 9-12, 14-20, 23, 25, and 26 depend from claim 1 or from claim 21 and therefore are also patentable over the combination of Filler and Yu.

3. Applicants respectfully submit that claim 4 is patentable over the combination of Filler, Yu and Beuk et al. (US 5,774,673, "Beuk").

Claim 4 depends from claim 1. Beuk fails to provide the features of claim 1 missing from the combination of Filler and Yu and therefore fails to render claim 4 unpatentable.

4. Applicants respectfully submit that claim 13 is patentable over the combination of Filler, Yu, and Peppel (US 6,200,216).

Claim 13 depends from claim 1. Peppel fails to provide the features of claim 1 missing from the combination of Filler and Yu and therefore fails to render claim 13 unpatentable.

5. Applicants respectfully submit that claims 8 and 24 are patentable over the combination of Filler, Yu and Treyz et al. (US 6,587,835), "Treyz").

Claim 8 depends from claim 1 and claim 24 depends from claim 21. Treyz fails to provide the features of claims 1 and 21 missing from the combination of Filler and Yu and therefore fails to render claims 8 and 24 unpatentable.

6. Applicants respectfully submit that claim 22 is patentable over the combination of Filler, Yu, and Atsmon et al. (US 6,607,136, ("Atsmon").

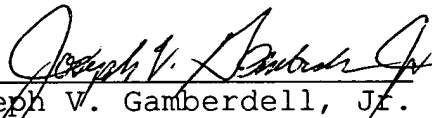
Claim 22 depends from claim 21. Atsmon fails to provide the features of claim 1 missing from the combination of Filler and Yu and therefore fails to render claim 22 unpatentable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and

are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Joseph V. Gamberdell, Jr.
Reg. No. 44,695

26 January 2005
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria VA 22313-1450.

Date: 1/26/05

Signature: Margaret Miran
Person Making Deposit